UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,149	01/28/2002	Seiichi Yano	020063	8179

23850 7590 12/18/2006

ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP
1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

EXAMINER	
FISHER, MICHAEL J	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 12/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/030,149	YANO ET AL.	
	Examiner	Art Unit	
	Michael J. Fisher	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 10-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8,10-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 1-3,8,13-23, there are no initiations that would enable one of ordinary skill in the to be able to know how to combine the factors described.

For instance, in claim 1 is the limitation, "...using data concerning resold vehicles such as..." without describing how to use the data. Further in claim 1 is the limitation, "...a first step with extracts... a second step which extracts... a third step which obtains multi-regression equation... for estimating..." There is no way to know what the "multi-regression equation" is or how to obtain it or how to use it to estimate a price.

All independent claims similarly lack enablement.

Further, as to claims 1,3 and 20, there is no enablement for the limitation included in each, "...wherein the sold price... are determined using data... including..." The language of these limitations make it so that all of the limitations are used while in

the specification the language concerning these features are shown to be "such as..." and thus, do not claim all of the limitations.

Note: Some claims with similar language, such as claim 2, include the limitations, "...such as..." which is the language that is enabled by the specification. The examiner will treat all claims as if they do not require all aspects as this is what is enabled by the specification.

Claims 4-7,10-12, 22 and 23 are rejected as depending from rejected claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 2,3, and 13-20, while the preamble to these claims clearly states they are directed toward a "system" (i.e. an apparatus). However, there is no structure to the system and further, the limitations are directed toward what appears to be a method and not a system. It is therefore impossible to know the scope of the claims.

Note: The independent claims, as amended, include the limitation, "...an estimated sold price calculation system using..." This language is not considered substance as the "correlation equation" could merely be a mental step and would not constitute 'structure'.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8, as best understood, and 21, are rejected under 35 U.S.C. 102(e) as being anticipated by US PAT 6,622,129 to Whitworth.

As to claim 8, as best understood, Whitworth discloses a method, system and program used to determine a vehicle resold value (title), using such criteria as model, optional equipment, model year (fig 2). Whitworth further teaches a using contract (lease).

Whitworth further teaches using a storage medium (fig 1). This would be used for profit and loss analysis (title).

As to claim 21, as best understood, Whitworth teaches a remaining value calculation (col U in fig 7) that uses vehicle information as claimed (cols A,B,C,D).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7,10-20,22 and 23, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 6,622,129 to Whitworth.

Whitworth discloses a method, system and program used to determine a vehicle resold value (title), using such criteria as model, optional equipment, model year (fig 2). Whitworth further teaches a using contract (lease).

As to claims 1,2, and 23, as best understood, Whitworth does not teach a 'multi-regression equation. It would have been obvious to one of ordinary skill in the art to use a multi-regression equation to ensure the result is accurate. The result is used to analyze profit and loss

As to claim 3, as best understood, Whitworth does not specifically teach a correlation equation. It would have been obvious to one of ordinary skill in the art to use a correlation equation as Whitworth is shown to correlate data using equations (fig 3).

As to claims 4 and 10, as best understood, Whitworth does not teach using mileage from the "actually using period" and storing it. It would have been obvious to

one of ordinary skill in the use actual mileage, and to store it, as it is very well known in the art for mileage to affect the value of an automobile.

As to claims 5 and 11, as best understood, Whitworth uses sedan type (col D in fig 5).

As to claim 6, the information is shown to be outputted (figs 5-7).

As to claim 7, the information is outputted at an arbitrary time (whenever it is ready).

As to claim 12, Whitworth discloses a display (as is inherent in a computer).

As to claim 14, as best understood, Whitworth uses a table to correlate data (figs 5-7).

As to claims 15-19, as best understood, Whitworth uses a contract length or "assumption using period) (lease terms).

As to claim 20, as best understood, Whitworth does not, however, specifically using standard deviation to perfect the data. It would have been obvious to one of ordinary skill in the art to use standard deviation as this is well know to be useful in refining numbers for accuracy.

As to claim 22, as best understood, Whitworth does not teach a secondary retrieval program, Whitworth does, however, teach extracting this information (figs 5-7). Therefore it would have been obvious to one of ordinary skill in the art to use a secondary program to ensure the data is correct.

Response to Arguments

Applicant's arguments filed 9/29/06 have been fully considered but they are not persuasive. As to arguments in relation to "multi-regression equation", the examiner agrees that the information is claimed. However, how to combine them to form such an equation is nowhere presented. Merely including a so-called "black-box" ("estimated sold price calculation system) that performs this step does not teach one of ordinary skill in the art how to make such a "calculation system". As to arguments in relation to the statutory class of the claims, the rejection of claim 1 under this has been removed, however, as discussed in the above rejection, the rest of the claims rejected under this rule are still so rejected. The rejection under 35 U.S.C. 101, have been removed. As to the arguments in relation to the rejection under 35 U.S.C. 102 and 103, the examiner did apply art against the preamble contra the arguments. The examiner will note that the language of the claims prior to amendment and as per the specification, not all factors are necessary. So for instance, the examiner used, "vehicle maker" and "model", however, the examiner could have made nearly all the limitations obvious, such as "displacement" and "engine cylinders" as it is very well known in the art for vehicles of different sized engines (displacement) and cylinders (6 vs. 8) to affect price of vehicles. For instance, a Ford Mustang with a V-8 is more costly than one with a V-6 engine and thus, the cost in this instance is affected by both displacement (as the V-8 is generally larger than the V-6 and the V-8 has more cylinders than the V-6). The examiner would also note that "residual value" is the estimated value of a vehicle made before it is resold. Mileage has been addressed in the above rejection and is considered to be old and well known to affect price of vehicles. The examiner did not assert that Whitworth

discloses correlation equations, the examiner asserted that it would be obvious to use a correlation equation as Whitworth discloses correlating value (title) using equations, (fig 3). Standard deviation is well known and obvious to use in any situation where inexact figures are listed. Further, vehicles are well known to be valued at ranges such as those values for "clean" and for "rough". As stated, the specification does not disclose requiring all features to be used. The only feature that the examiner would possibly not be obvious would be roof-shape. However, this limitation is not described adequately and would appear to the examiner to be used to describe the difference between a coupe and a convertible or between a vehicle without or with a moon- or sun-roof or targa-top and these are all well known to affect the value of a vehicle. All else being equal, a convertible is generally worth much more than a coupe. If there is another explanation as to why or how "roof-shape" would affect the cost of the vehicle the examiner would entertain such arguments. However, the examiner is not aware of any other differing "roof-shapes" in any vehicle that would affect price. Vehicle shape would be "2-door" or "4-door" or "hatchback".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF

12/07/06

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600